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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/073,942   | 02/14/2002  | Matthew D. Putnam    | 09531-075001                 | 1734             |
| 26191  | 7590        | 01/06/2005           |                              |                  |
| FISH & RICHARDSON P.C.<br>3300 DAIN RAUSCHER PLAZA<br>60 SOUTH SIXTH STREET<br>MINNEAPOLIS, MN 55402 |             |                      | EXAMINER<br>REIP, DAVID OWEN |                  |
|  |             |                      | ART UNIT<br>3731             | PAPER NUMBER     |

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/073,942

Applicant(s)

PUTNAM ET AL. 

Examiner

David O. Reip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Election/Restrictions*

Claims 1 and 38 are generic to a plurality of disclosed patentably distinct species comprising:

| <u>Species of plate</u>     | <u>Representative figure</u> |
|-----------------------------|------------------------------|
| 1                           | 3                            |
| 2                           | 10                           |
| 3 (with articulating tines) | 49                           |
| 4 (with articulating tines) | 56                           |
| 5                           | 58                           |
| 6 (with articulating tines) | 68                           |

| <u>Species of tensioning device</u> | <u>Representative figure</u> |
|-------------------------------------|------------------------------|
| 1                                   | 31                           |
| 2                                   | 33                           |
| 3                                   | 35                           |
| 4                                   | 39                           |
| 5                                   | 41                           |
| 6                                   | 44                           |

| <u>Species of articulating tines</u> | <u>Representative figure</u> |
|--------------------------------------|------------------------------|
|--------------------------------------|------------------------------|

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|   |    |
|---|----|
| 1 | 48 |
| 2 | 51 |
| 3 | 54 |

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Further, the application includes claims directed to several subcombinations of devices that have been separately claimed in combination with the basic kit invention of a plate and at least one tensioning device, as follows:

A. A drill guide, in four species as listed below:

| <u>Species of drill guide</u> | <u>Representative figure</u> |
|-------------------------------|------------------------------|
| 1                             | 16                           |
| 2                             | 18                           |
| 3                             | 20                           |
| 4                             | 65                           |

- B. A drill bit
- C. Written instructions
- D. An instructional video
- E. A tensiometer
- F. A monitor
- G. A therapeutic agent, one or both of a bone growth regulating protein and a platelet derived growth factor
- H. A screw driver and/or and Allen wrench

All of the above subcombinations of A-H have separate utility apart from their respective combinations with the basic kit invention of the plate and the at least one tensioning device. Therefore, applicant must elect ONE combination for action on the merits, the combination being either the basic kit invention by itself or the basic kit invention in combination with one of the subcombinations of A-H as listed above. An election of a species of plate configured for use with articulating tines would require a further election of a species of articulating tines. An election of the subcombination "A" (the drill guide) would require an additional election of a species of drill guides.

A telephone call was made to Mr. William Hare on 1/4/05 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

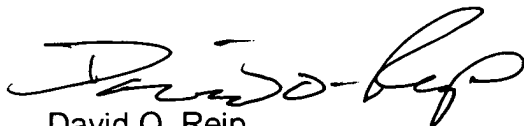
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David O. Reip whose telephone number is 571-272-4702. The examiner can normally be reached on 7 A.M.- 4 P.M. Mon-Thu and every other Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "David O. Reip", is positioned above the printed name.

David O. Reip  
Primary Examiner  
AU 3731